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REMARKS

Applicants have thoroughly considered the Examiner's remarks in the May 2, 2005 Office action. Claims 3, 4, 7, 13, 21 and 23 have been canceled by this Amendment B. Claims 1, 2, 5, 6, 8-12, 14-20, 22, and 24-31 are presented by this Amendment B for further consideration. Reconsideration of the application claims as amended and in view of the following remarks is respectfully requested.

The subject matter of canceled claims 7, 13 and 23 related to a customizable script defining a staging order in which the programs are to be staged. Independent claims 1, 19 and 31 have been amended to include this subject matter. Thus, independent claim 1 corresponds to claim 7 in independent form and independent claim 19 corresponds to claim 21 in independent form. Independent claim 31 presents the same subject matter. The dependent claims have been amended to be consistent with the amended independent claims. Accordingly, no new issues are presented by this Amendment B so that applicants respectfully request entry and consideration of this Amendment B under Rule 116.

Claims 1-3, 10, 11, 13-15, 18-23, 25, 28, and 31 stand rejected under 35 U.S.C. §102(e) as being unpatentable over Harding (U.S. Pat. No. 5,794,052). Claims 4-7, 12, and 24 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Harding patent in view of "Microsoft Windows 2000 Server Unleashed" by Brown et al. Claims 8, 9, 26 and 27 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Harding patent in view of "Windows 95 Installation and Configuration Handbook" by Tidrow et al. Claims 16, 17, 29 and 30 stand rejected under 35 U.S.C. §103(a) as being unpatentable over the Harding patent in view of Brown in view of "Background of the Invention," columns 1-4 of Harding.

Since independent claims 1, 19 and 31 present the subject matter of claims 7, 13 and 23 in independent form, only the rejections directed to claims 7, 13, and 23 will be addressed. Applicants submit that the remaining claims each depend from independent claims 1 or 19 so that the remaining claims are patentable for at least the same reasons as independent claims 1 and 19.

<u>Claim 7 stands rejected under 35 U.S.C. §103(a)</u>
<u>as being unpatentable over the Harding patent in view of Brown.</u>

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With regard to claim 7, the Examiner cites column 11, lines 1-4 of Harding:

FIX$FILE.BAT executes each module's batch program which runs each modules's script file located in the TEMP directory in the order that the modules are downloaded onto the hard disk drive 310.

As noted above, claims 1, 19 and 31 have been amended to recite that subject matter of claims 7, 13 and 23 specifying that the user customizable script specifies the **staging order**. Applicants submit that independent claims 1, 19 and 31, and the claims depending therefrom, are patentable. In particular, claim 1 recites performing functions on the reference system computer according to a customizable script defining an **order** in which the programs are to be **staged**; similarly, claim 19 recites a computer-readable medium having computer-executable instructions identifying the staged programs for installation on the destination computer and including a customizable script defining an **order** in which the programs are to be **staged**; and, similarly, claim 31 recites a second data field including a customizable configuration script for directing the destination computer in performing functions and for defining an **order** in which the programs are to be **staged**.

Applicants respectfully disagree with the Examiner's interpretation of Harding and submit that the Office action does not provide full weight to the language of the claims and the recitations specified therein. In fact, Harding fails to recognize that the **staging order** is important to reduce conflicts and re-booting. In contrast to Harding, according to one embodiment of the invention, a configuration script (*e.g.*, a text file such as WINBOM.INI) directs the installation utility FACTORY.EXE and controls the **staging order** in which programs are installed or staged on the reference system and re-boots the reference system as necessary. Thus, the invention employs a script to determine which programs are to be attached, detached, or uninstalled on the target machine and to control the **staging order** in which the staged programs are attached, detached, or uninstalled on the target machine. For example, OEMRUNONCE permits **ordering**, *i.e.*, the OEM can instruct the computer to execute the OEMRUNONCE commands in a particular **order** to prevent conflicts and the like between the commanded operations. Harding fails to recognize that there may be conflicts so that the **staging order** must be considered.

Even if it is assumed that Harding controls the order (which assumption has no basis in Harding), the Harding patent is still deficient with respect to amended independent claims 1, 19 and 31. This is because Harding does not recognize that the **staging order** can be specified by a

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user customizable script, as recited by each of the independent claims. Rather, Harding teaches that the download order must control the order of execution, which is troublesome and limiting in certain configurations. The Examiner admits the Harding does not disclose a customizable script on page 9 of the Office action. Applicants do not understand the Examiner's rejection that Harding teaches the recited customizable script specifying a **staging order** when Harding does not disclose a script.

Applicant's note that the Examiner did not cite Brown as a basis for rejecting claim 7 relating to **staging order** even though Brown is cited as teaching a script. In any case, applicants submit that Brown is deficient for the same reasons as noted above in that the script of Brown does not address **staging order** controlled by a customizable script. Furthermore, there is nothing in Harding or Brown which would suggest their combination. "[T]he question is whether there is something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." *Lindemann MaschinenFabrick GMBH v. American Hoist and Derrick Company*, 730 F.2d 1452, 1462; 221 U.S.P.Q. 481, 488 (Fed. Cir. 1984). As has been shown, the non-analogous teachings of the prior art relate to different fields of endeavor and are directed to entirely different problems. Therefore, nothing in the cited references suggest their combination. Indeed, the Examiner failed to cite any basis whatsoever for combining these references. In fact, the Examiner's rejection provides a text book example of impermissible hindsight analysis -- the Examiner used the invention as defined by the claims as a guide to pick and choose non-analogous references in order to reject the claims. See *In re Oetiker*, 977 F.2d at 1447; 24 U.S.P.Q.2d at 1446 ("There must be some reason, suggestion, or motivation found in the prior art whereby a person of ordinary skill in the field of the invention would make the combination. That knowledge can not come from the applicant's invention itself."). Thus, applicants submit that the combination of Harding and Brown does not render the claimed invention obvious.

Finally, a plain reading of Harding shows that it is deficient because it teaches away from the invention by stating that the modules are executed in the order that they are downloaded. In fact, one purpose of the invention is to allow the user, via a customizable script, to specify the **staging order** independent of the downloading. In contrast to merely downloading programs as taught by Harding, applicants' claimed invention includes *staging the order of* programs on a storage medium of the destination computer for *later installation* on the destination computer,

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wherein the staging of the programs comprises *storing installation files* for the programs on the destination computer and *attaching the selected program* to complete the installation thereof on the destination computer.

For example, an original equipment manufacturer (OEM) can create a reference on a blank system hard drive for use in building destination computers for ultimate distribution to end users. Rather than fully installing a program, the OEM can set up the reference system so that it stages the program *in a user specified order* (*i.e.*, copies the needed installation files locally). In this manner, the program is available in the reference image for later installation. As described in the present application, staging a program involves copying the needed installation files to a target machine but not fully integrating the staged program with the operating system, which occurs when the program is attached. In one embodiment, a staged installation of a program can be accomplished by indicating the name of the setup file and the location of the setup files along with a desired destination. Attaching the selected staged program involves incremental processing to fully install the software (*e.g.*, final placement of registry entries, desktop shortcuts, shared files, etc.). See application page 10, lines 3-9 and page 13, lines 7-9.

In summary, Harding is deficient because of three reasons. First, Harding fails to recognize that the **staging order** is important to reduce conflicts and re-booting. Second, Harding is deficient because it fails to recognize that the **staging order** can be controlled by a user customizable script. Third, Harding is deficient because it teaches away from the invention by stating that the modules are executed in the order that they are downloaded. In addition, Harding and Brown cannot be combined and, even if combined, the combination does not render the claims obvious.

Accordingly, applicants submit that independent claims 1, 19 and 31, and the claims depending therefrom, are patentable so that the rejection based on §103(a) should be withdrawn. In particular, claim 1 recites performing functions on the reference system computer according to a customizable script defining an order in which the programs are to be staged; similarly, claim 19 recites a computer-readable medium having computer-executable instructions identifying the staged programs for installation on the destination computer and including a customizable script defining an order in which the programs are to be staged; and, similarly, claim 31 recites a second data field including a customizable configuration script for directing the destination

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computer in performing functions and for defining an order in which the programs are to be staged.

Applicants note that the Brown reference fails to remedy the deficiencies of the primary reference noted above. The Brown reference is entirely silent as to the aspect of *staging order* a program for *later installation* on the destination computer by *storing installation files* for the programs on the destination computer as set forth in the claims. Therefore, applicants submit that the Harding and Brown references, whether considered separately or together fail to teach or suggest each and every feature of the claimed invention. Therefore, the rejection under section 103 should be withdrawn.

Applicants request that the Examiner cite a reference which teaches a user customizable script controlling the **staging order** or remove the rejection.

Claims 13 and 23 stand rejected under 35 U.S.C. §102(e)

as being unpatentable over Harding.

With regard to claims 13 and 23, the Examiner cites column 5, lines 38-43 of Harding:

Once all of the module files, including its associated script file, are exploded and downloaded onto the hard disk drive, the FIX$FILE.BAT program runs the batch files associated with each installed module in the order that the modules are downloaded. The module batch files include an instruction to run the SCRIPT.EXE program.

As noted above, claims 1, 19 and 31 have been amended to recite that subject matter of claims 7, 13 and 23 specifying that the user customizable script specifies the **staging** order. Applicants submit that independent claims 1, 19 and 31, and the claims depending therefrom, are patentable. Once again, applicants respectfully disagree with the Examiner's interpretation of Harding and submit that the Office action does not provide full weight to the language of the claims and the recitations specified therein.

Advantageously, the staging of programs **IN A PARTICULAR ORDER AS SPECIFIED BY A USER CUSTOMIZABLE SCRIPT**, as opposed to downloading and fully installing them as taught by Harding, requires less memory and permits more flexibility. For this reason, a greater number of high attach rate programs may be available in a reference image for a given storage space. This provides a greater variety of final system configurations. Moreover, staging saves the OEM time if it chooses to install a particular application at a later time because

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it does not need to, for example, copy the application installation files over a network or from a CD, or run the installation over the network as described in the Harding patent. See application page 11, lines 6-12.

Claim 1 is directed to a computerized method of installing selected programs on a destination computer. The method of claim 1 includes defining a reference system comprising a computer that has an operating system installed thereon and the programs previously staged thereon wherein the defining includes performing functions on the reference system computer according to a customizable script defining an order in which the programs are to be staged. Claim 19 is directed to a system for configuring a computer. The system of claim 19 includes a reference computer having *programs staged thereon for later installation* and a destination computer executing instructions to attach an identified program to *complete the installation* of the identified program on the destination computer and including a customizable script defining an order in which the programs are to be staged. Inasmuch as the Harding patent merely teaches downloading software program modules from a mass data storage device to a hard disk drive, applicants submit that claims 1 and 19 is allowable over the cited art. Claims 2, 4, 6, 8-12, 14-18, 20, 22, and 24-30 are believed to be allowable for at least the same reasons as claims 1 and 19 from which they depend.

Amended claim 31 recites a data structure storing a customizable configuration script for directing the destination computer in identifying at least one of the *staged programs for later installation* based on the data identifying the staged programs and for *defining an order* in which the programs are to be staged. As noted above, applicants submit that the Harding patent fails to teach or suggest this aspect of staging as claimed by applicants in claim 31. Therefore, claim 31 is believed to be allowable over the cited art.

In light of the foregoing, applicants submit the cited art fails to teach or suggest each and every aspect of claims 1, 19 and 31, and the claims depending therefrom. Therefore, Claims 1, 2, 4, 6, 8-12, 14-20, 22, and 24-31 are believed to be allowable over the cited art.

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Conclusion

It is felt that a full and complete response has been made to the Office action and, as such, places the application in condition for allowance. Such allowance is hereby respectfully requested. Although the prior art made of record and not relied upon may be considered pertinent to the disclosure, none of these references anticipates or makes obvious the recited invention. If the Examiner feels, for any reason, that a personal interview will expedite the prosecution of this application, he is invited to telephone the undersigned.

The Applicants wish to expedite prosecution of this application. If the Examiner deems the claims as amended to not be in condition for allowance, the Examiner is invited and encouraged to telephone the undersigned to discuss making an Examiner's amendment to place the claims in condition for allowance.

Any required fees or overpayments should be applied to Deposit Account No. 19-1345.

Respectfully submitted,

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